

REMARKS/ARGUMENTS

In the above-mentioned Final Rejection, claims 230, 232 and 238 were rejected as being indefinite, claims 226-230 and 238-262 were rejected as being anticipated by U.S. Patent 5,484,168 (Chigot), and claims 142-150, 178, 180-183, 187-189, 218, 219, 231 were allowed. In response thereto, claims 226-237, 249, 250, 252, and 255-260 were cancelled, and claims 239, 241, 244, 246, 248, 251, 253, and 262, were amended, and new claims 263-281 were added.

The allowance of claims 142-150, 178, 180-183, 218 and 219 is acknowledged with appreciation, and these claims remain in the application.

The Examiner contended that a "bar" was not shown in the application. The bar is shown for example in FIG. 16 by the structure as shown where the lead lines for reference numerals 364 and 374 point and to which the label liner sheet portions 354 are connected.

The Examiner further stated in rejecting many of the claims that no patentable weight is given to "intended use phrases."

Although the Applicants respectfully traverse those rejections, many of the claims have been amended to use the descriptive phrase "adapted to." Language in the body of the claim following the description phrase "adapted to" is in fact a structural limitation, as a matter of law. For example, *In re Venezia*, 189 U.S.P.Q. 149 (CCPA 1976), some of the claim language at issue was "a pair of elastic sleeves ... adapted to be fitted over the insulating jacket of one of said cables." *Id.* at 150. Concerning the above quoted aspect of the claim, the CCPA stated that: "rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is constructed or dimensioned so that it can be fitted over the insulating jacket of the cable." *Id.* at 151-152, emphasis added.

It is also well-settled that all limitations must be considered and it is improper to ignore specific limitations in the claim that distinguish over the cited references. See, e.g., *In re Boe and Duke*, 184 U.S.P.Q. 38, 40 (CCPA 1974). Accordingly, Applicants respectfully submit that respective portions of the claims that follow the descriptive phrase "adapted to" are structural limitations that must be afforded the same weight as any other limitations recited in the body of the claim.

Further, some of the claims have been amended and some of the new claims are in "means plus function" format and thus the claimed function pursuant to the patent statute must be considered in any patentability determination.

The independent claims discussed below are patentable for at least the following reasons.

Independent claim 238 includes the liner strip including liner sheet portions adhered to respective ones of the facestock labels before the liner strip is positioned in the separated position and the liner strip further including a liner sheet bar to which the liner sheet portions are connected. The "bar" element has been explained above.

Independent claim 239 includes a plurality of longitudinally-aligned facestock labels. Chigot for example, does not show longitudinally aligned facestock labels. The facestock includes ties between adjacent labels and which connect the labels together when in a line on the liner sheet and allow the labels to be separated to position them on the (at least one) surface.

Independent claim 241 includes longitudinally-aligned facestock first labels aligned in a first line and longitudinally-aligned facestock second labels aligned in a second line spaced from and parallel to the first line. Further, the liner sheet includes a removable second liner strip disposed substantially between the aligned facestock first and second lines of labels.

Independent claim 243 includes the liner strip including a plurality of protruding portions to which respective facestock labels are directly adhered before the liner strip is positioned in the separated position. This is shown by the liner sheet portions 354 in FIG. 16, for example.

Independent claim 244 includes a plurality of longitudinally-aligned face stock labels and the liner strip adapted to be positionable in the different positions as specified in the last paragraph of the claim.

Independent claim 246 includes adhesive means for adhering the liner strip to the facestock labels with the liner strip is in the attached position and also for adhering the labels to the staggered tabs when the labels are in the applied position.

Independent claim 248 includes the first liner strip and the second liner strip as claimed as well as aligned first facestock labels and aligned second facestock labels.

Independent claim 251 includes the facestock labels when in the exposed position extend out from an edge of the liner sheet. This is shown for example in FIG. 16 by labels 360 and 332. The claim further includes a second liner strip as defined in the last paragraph.

Independent claim 253 includes adhesive means on the facestock for holding the first and second liner strips together until the first liner strip is separated to the separated position. This can be understood from FIGS. 15-19.

Independent claim 254 includes the facestock labels being serially interconnected with breakable facestock thin connector strips as shown for example at 558 in FIGS. 24 and 27.

Independent claim 261 includes at least one facestock weakened line through the facestock, and defining at least a portion of perimeters with more than two aligned facestock labels.

Independent claim 262 includes longitudinally-aligned facestock labels and a first facestock strip adhered to the first liner strip and a second facestock strip adhered to the second liner strip.

Independent claim 263 includes longitudinally-aligned second facestock labels in a second line which is parallel to the first line of the longitudinally-aligned facestock first labels.

Independent claim 273 includes liner strip means as set forth in the last paragraph of that claim.

Independent claim 281 includes portions of the label extending out beyond an edge of the liner body portion when the liner strip is in the removed position. This is shown in FIG. 16 for example as mentioned above.

An anticipation rejection requires that the Examiner show where each and every claim element is located in the prior art reference. The Examiner has not made that showing, Applicants respectfully contend. Specifically, MPEP Section 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 1053 (Fed.Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989). The elements must be arranged as required by the claim...

It is thus respectfully submitted that the subject application is in condition for allowance. If there are any remaining issues, the Examiner is encouraged to telephone counsel at (213) 689-5142 to seek to resolve them.

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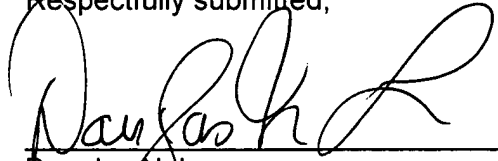
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The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,


Douglas N. Larson
Registration No. 29,401

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SQUIRE, SANDERS & DEMPSEY L.L.P.
801 South Figueroa Street, 14th Floor
Los Angeles, California 90017-5554
Telephone: (213) 624-2500
Facsimile : (213) 623-4581

LosAngeles/134824.1
11286.01105